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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,248	02/14/2001	Carl P. Decicco	PH-7064 (BMS-0685)	1696

23914 7590 08/26/2004
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EXAMINER

RUSSEL, JEFFREY E

ART UNIT PAPER NUMBER

1654

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/783,248

Applicant(s)

DECICCO ET AL.

Examiner

Jeffrey E. Russel

Art Unit

1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 4, 5, 19, 47, 51-56, 60-64, 68, 72-74 and 78.

Claim(s) objected to: 6-11, 15, 17, 20-46, 57-59, 65-67, 69-71, 75 and 77.

Claim(s) rejected: 12-14, 16, 18, 48-50 and 76.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Attachment: Examiner-Initiated Interview Summary, PTOL-413B

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1. The proposed amendment after final rejection filed July 29, 2004 will not be entered because it is not in compliance with 37 CFR 1.121. Claims 56, 61, 62, 68, 73, and 74 use a status identifier, “(previously amended)”, which is not permitted by 37 CFR 1.121(c). In claims 61, 63, and 64, “Claim” was changed to “claim” without marking the change by strikethrough and underlining as required by 37 CFR 1.121(c)(2).
2. The proposed amendment to the specification would have overcome the objection set forth in section 1 of the final Office action.
3. The proposed amendments to the claims raise the following new issues: Proposed amended claims 12 and 14 do not define the variable R^{15} which occurs in these claims. Proposed amended claim 13 does not define the variable R^{16} which occurs in this claim. Proposed amended claim 16 defines variables which are not used in any of the chemical formulas set forth in proposed amended claim 47. There is no antecedent basis in proposed amended claim 47 for the phrase “the chelator” at line 2 of the claim. Note that a chelator is not mentioned until line 5. Proposed amended claim 47 at line 8 refers to the formula (Ia) or (Ib); however, only one formula is set forth in the remainder of the claim. At proposed amended claim 47, page 6 of the amendment, last line, “group” should be inserted after “linking”. At proposed amended claim 47, page 7, line 4, the claim recites “0-3 additional heteroatoms”, which is altered from finally rejected claim 6, page 11, line 16 (“0-2 additional heteroatoms”) and originally-filed claim 6, page 136, lines 3-4 (“0-3 heteroatoms”). It is not clear if this change was intentional, and it is not clear how the required nitrogen atom should be taken into account when counting the number of heteroatoms. It also appears that proposed amended claim 47, page 6, line 23, should be amended in a similar manner because any ring formed from N, R^{10} , and R^{11} will contain at least

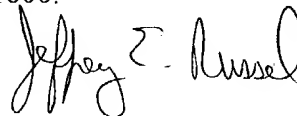
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1 nitrogen heteroatom. There is no antecedent basis in the claim for the phrase "the cytotoxic radioisotope" at proposed amended claim 50, last line. At proposed claim 62, "radiopharmaceutical" should be inserted before "kit" so as to be consistent with the terminology of claim 61.

4. Aside from the errors noted above, Applicants' proposed amendments would have successfully limited the claimed subject matter to that disclosed in provisional application 60/182,627, and would have overcome the rejections set forth in sections 6-8 of the final Office action because Carpenter, Jr. et al (U.S. Patent No. 6,656,448) and Liu (U.S. Patent Application Publication 2002/0004032) would no longer be prior art against the proposed amended claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
August 17, 2004